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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,699	07/27/2000	William John Jones	9010/96559 (01-0101)	9907
22242	7590	04/28/2010	EXAMINER	
FITCH EVEN TABIN & FLANNERY			TODD, GREGORY G	
120 SOUTH LASALLE STREET			ART UNIT	PAPER NUMBER
SUITE 1600			2457	
CHICAGO, IL 60603-3406				

  

MAIL DATE	DELIVERY MODE
04/28/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/626,699	JONES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	GREGORY G. TODD	2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 January 2008.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 46-53,56-63 and 66-72 is/are pending in the application.
- 4a) Of the above claim(s) 71 and 72 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 46-53,56-63 and 66-70 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/22/08,9/18/07, 8/28/09.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to applicant's amendment filed 22 January 2008 of application filed, with the above serial number, on 27 July 2000 in which claims 46-53, 56-63, and 66-67 have been amended and claims 68-72 have been added. Claims 46-53, 56-63, and 66-72 are therefore pending in the application.

### ***Election/Restrictions***

2. Newly submitted claims 71-72 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 71-72 recite the specific functionality of the RNC and SGSN, as well as the use of a (Layer 2) tunneling protocol access concentrator.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 71-72 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 67 recites the limitation "the (UE)" in line 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 46-50, 56-60, 66-67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al (hereinafter "Fujiwara", 6,064,879) in view of Lipsit (hereinafter "Lipsit", 5,956,636), and further in view of Vilander et al (hereinafter "Vilander", 6,618,592).

As per Claim 46, Fujiwara teaches a method for a server of a wireless network for registering a user equipment (UE) accessing the Internet through a Universal Mobile Telecommunications System (UMTS) access network, the method comprising:

establishing an anonymous communication session, with the UE in response to authentication of a temporary ID and a temporary password identifying the user equipment as unregistered (authenticating temporary telephone number and ID) (at least col. 1, lines 31-60; col. 3 line 60 - col. 4 line 5; Fig. 3; col. 4, lines 15-35);

transmitting to the UE, via the anonymous communication session with the UE, a reply message comprising a request for registration information (at least col. 7 line 54 - col. 8 line 16; permanent).

Fujiwara fails to explicitly teach receiving, from the UE, in response to the request for registration information, a permanent ID and a permanent password. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit. Lipsit teaches a recipient using a wireless device being prompted and requested to input a security code as well as an ESN to be sent to the MSC for the wireless device to be activated/registered (at least col. 9, lines 13-54). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Lipsit's system into Fujiwara as Lipsit's alternative activation/registration process allows the end recipient to activate the device using the ESN and security code of their choice.

Fujiwara and Lipsit fail to explicitly teach using a tunneling communications protocol via an Integrated Network Controller (INC). However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Vilander. Vilander teaches a RNC using tunneling for Internet communications with a mobile terminal (at least col. 4:20-40; 2:7-20). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate Vilander's Internet access design with Fujiwara and Lipsit, as Vilander teaches Layer 2 Tunnelling Protocol being commonly used in a UMTS system and this would enhance Fujiwara and Lipsit's system for communication with the Internet over UMTS.

As per Claim 47, Fujiwara fails to explicitly teach the requested registration information further comprises indicia of a preferred service provider, and the step of receiving, from the UE, in response to the request for registration information, includes receiving the indicia of a preferred service provider from the user equipment. However, the use and advantages for using such a service is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit (at least col. 6, lines 39-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Lipsit's service provider choosing into Fujiwara's system as this would allow the user to use the pre-registered mobile unit with any service provider upon initial connection and not be limited to any one specific service provider as Lipsit teaches the customer calling the provider of their choice.

As per Claim 48, the method of claim 46 wherein the requested registration information further comprises indicia of a requested type of service (user entering information) (at least col. 7, lines 3-53).

As per Claim 49, the method of claim 46 wherein the requested registration information further comprises a preferred user name (user entering information) (at least col. 7, lines 3-53).

As per Claim 50, the method of claim 46 wherein the reply message further comprises at least one protocol filter to restrict an access to the wireless network by the user equipment (at least col. 4, lines 15-34; restricting access).

As per Claim 56, Fujiwara teaches a method for a user equipment (UE) for registering with a server of a wireless network for accessing the Internet through a UMTS access network, comprising:

transmitting a temporary ID and a temporary password identifying the user equipment as unregistered, for authentication with the server (temporary telephone number and ID) (at least col. 3 line 60 - col. 4 line 5; Fig. 3; col. 4, lines 15-35);  
receiving, via the anonymous communication with the server, a reply message comprising a request for registration information, the registration information comprising a permanent ID and a permanent password (at least col. 7 line 54 - col. 8 line 16; permanent); and

transmitting the requested registration via the anonymous communication session with the server (at least col. 7 line 54 - col. 8 line 16; Fig. 15).

Fujiwara fails to explicitly teach receiving, from the UE, in response to the request for registration information, a permanent ID and a permanent password. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit. Lipsit teaches a recipient using a wireless device being prompted and requested to input a security code as well as an ESN to be sent to the MSC for the wireless device to be activated/registered (at least col. 9, lines 13-54). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Lipsit's system into Fujiwara as Lipsit's alternative

activation/registration process allows the end recipient to activate the device using the ESN and security code of their choice.

Fujiwara and Lipsit fail to explicitly teach using a tunneling communications protocol via an Integrated Network Controller (INC). However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Vilander. Vilander teaches a RNC using tunneling for Internet communications with a mobile terminal (at least col. 4:20-40; 2:7-20). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate Vilander's Internet access design with Fujiwara and Lipsit, as Vilander teaches Layer 2 Tunnelling Protocol being commonly used in a UMTS system and this would enhance Fujiwara and Lipsit's system for communication with the Internet over UMTS.

Claims 57-60, 66-67, and 69 do not substantially add or define any additional limitations over claims 46-50, and 56 and therefore are rejected for similar reasons.

6. Claims 51-53 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Lipsit and Vilander, and further in view of Rai (hereinafter "Rai", 6,675,208).

Fujiwara and Lipsit fail to teach the reply message further comprising passing, from the registration server arrangement to the computer, a designation for an Internet service provider that the user equipment may access via the wireless network, registration web page information, and registration software program for execution by

the user equipment. However, the use and advantages for using such registration information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rai. Rai teaches wireless service providers providing internet access to end users (at least col. 5, lines 46-55; col. 8, lines 10-30; col. 43, lines 5-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Rai's registration methods into Fujiwara and Lipsit's system as this would further enhance Fujiwara and Lipsit's system by allowing the registration process to occur using the internet as selected by the user in Rai, to offer more functionality and ease of use in setting up such registration of the computer and as these are well known variations in the art for registering subscribers.

7. Claims 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Lipsit and Vilander, and further in view of Bertrand et al (hereinafter "Bertrand", 6,687,252).

Fujiwara, Lipsit, and Vilander teach wherein the INC comprises a tunneling protocol access concentrator and a Radio Network Controller (RNC) (at least Vilander col. 4:20-40; 2:7-20), but fail to teach the INC comprising also a Serving GPRS Support Node (SGSN) and a RADIUS client. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Bertrand. Bertrand teaches a mobile terminal accessing a SGSN and Radius client (at least col. 10:48-51; 4:56-64). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to

incorporate the use of Bertrand with Fujiwara, Lipsit, and Vilander's system because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

***Response to Arguments***

8. Applicant's arguments with respect to claims 46-53, 56-63, and 66-72 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Short et al and Chuah, in addition to previously cited Holmes, Mosher et al, Hawkins, Grube et al, Dailey, Vilander et al, Larkins, Tiedemann, Freitag et al, Chatterjee et al, Jones et al, and Ronneke are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/G. G. T./  
Examiner, Art Unit 2157

/Ario Etienne/  
Supervisory Patent Examiner, Art Unit 2157